

## REMARKS

In the Office Action mailed June 30, 2008, the Examiner noted that claims 1-3, 6-9, 12-15, 18, 19, 22, and 23 were pending, that claim 23 has been withdrawn from consideration, and rejected claims 1-3, 6-9, 12-15, 18, 19 and 22. No claims have been amended, no claims have been canceled, no new claim has been added; and, thus, in view of the foregoing claims 1-3, 6-9, 12-15, 18, 19, 22 and 23 remain pending for reconsideration which is requested. No new matter is believed to have been added. The Examiner's rejections are respectfully traversed below.

### Election/Restriction Requirement

The Office Action, on page 2, constructively elected claims 1-3, 6-9, 12-15, 18, 19 and 22 for prosecution on the merits and withdrew claim 23 from consideration as being directed to a non-elected invention. Particularly, the Office Action asserted that independent claims 1, 7, 13, 19 and 22 are directed towards an employee communications system and claim 23 is directed to a distinct invention. However, it is submitted that the assertion by the Office Action is incorrect.

According to MPEP § 821.03, if, after an office action on an application, the applicant presents claims directed to an invention distinct from and independent of the invention previously claimed, the applicant will be required to restrict the claims to the invention previously claimed if the amendment is entered, subject to reconsideration and review as provided in §§ 1.143 and 1.144. However, in this case, claim 23 is neither independent nor distinct from the previously presented claims. According to MPEP § 802.01, the term "independent" means that there is no disclosed relationship between the two or more inventions claimed, that is, they are unconnected in design, operation, and effect. For example, a process and an apparatus incapable of being used in practicing the process are independent inventions. See also MPEP § 806.06 and § 808.01.

In claim 1, for example, the information processing apparatus receives an information inquiry from a terminal connected through a communication pathway ... [and] stores the inquiry information for each member of an organization. Claim 23 also receives employee information. Moreover, in claim 1, the information processing apparatus stores "advertising information **being sent** from an advertising company". Likewise, in claim 23, the advertisement information is **received** from an advertisement company.

According to MPEP § 802.01, related inventions are distinct if the inventions as claimed are not connected in at least one of design, operation, or effect (e.g., can be made by, or used in, a materially different process) and wherein at least one invention is PATENTABLE (novel and nonobvious) OVER THE OTHER (though they may each be unpatentable over the prior art). See MPEP § 806.05(c) (combination and subcombination) and § 806.05(j) (related products or related processes) for examples of when a two-way test is required for distinctness.

In claim 1, an inquiry image display generator that generates display data from the inquiry information file and the advertisement information file so that a display image of the display data contains ... the advertising information ... [and] an inquiry information transmitter ... transmits the inquiry image. Likewise, in claim 23, “the employee” is provided, “by an employee information apparatus, with advertisements based upon the employee information”. Therefore, it is submitted that claim 23 is neither distinct nor independent from claims 1, 7, 13, 19 and 22. Thus, the Examiner is respectfully request to overturn the Election/Restriction Requirement and reinstate claim 23.

### **Rejection under 35 U.S.C. § 103**

The Office Action, on page 3, rejected claims 1-3, 6-9, 12-15, 18, 19 and 22 under 35 U.S.C. § 103 (a) as being unpatentable over Valentino (U.S. Patent No. 4,648,037) in view of Kramer et al. (U.S. Patent No. 6,327,574, hereinafter “Kramer”).

Valentino is related to a comprehensive employee benefit and financial communication system that includes a conveniently located center (see column 1, lines 7-10 of Valentino). The center is located on the premises and has an easy-to-use unattended computer that an employee having no formal training can operate for a number of purposes, i.e. inquiries, transactions, and forecasts concerning benefits, saving plans, and financial services (see column 1, lines 10-16 of Valentino).

The Office Action acknowledged that Valentino does not teach that the advertisements in which data is collected regarding the success of the promotion and said data is forwarded to the advertisers in a privacy protected manner (see Office Action, page 4, lines 18-21) and relies on Kramer to teach the above quoted features. Particularly, the Office Action asserted that Kramer discloses that “any structured document may be illuminated [i.e. placed] with advertisements ... [and that] the illumination process described by Kramer processes all personal data on the client side (the terminal used by the user) to maintain privacy” (see Office Action, page 4, line 22 to page 5, line 1 and page 5, lines 6-7).

However, even if the assertions set forth by the Office Action are correct, Kramer still fails to disclose, either expressly or implicitly, the feature “information inquiry apparatus ... comprising ... a product promotion analyzer that computes ... and sends the product promotion result of more than one member in aggregate to the advertising company”, as recited in claim 1. As admitted by the Office Action, Kramer describes that the illumination process is processed on the client side and not in a separate apparatus, as recited in claim 1 (see Figure 1 of application).

Further because “the product promotion analyzer”, as recited in claim 1, is located in the “information inquiry apparatus” rather than the user terminal or at the advertising company “privacy is ensured for the more than one member” when the product promotion result is sent to the advertising company. Kramer does not disclose, either expressly or implicitly, such a configuration and/or feature. Rather, as admitted by the Examiner (see Office Action, page 5, lines 6-7), Kramer describes performing all processes on the terminal used by the user and not in a separate apparatus.

Therefore, one of ordinary skill in the art would not have been motivated, at the time invention was conceived, to include a “product promotion analyzer” in an information inquiry apparatus, which is separate from the user terminal. Kramer also fails to provide a suggestion, modification, or teaching of an “information inquiry apparatus ... comprising ... [of] a product promotion analyzer that computes ... and sends the product promotion result of more than one member in aggregate to the advertising company”, as recited in claim 1.

Furthermore, as admitted by the Office Action (see Office Action, page 5, lines 1-6), Kramer describes illuminating, i.e. replacing, sections of documents with targeted content, i.e. advertisements (see Kramer, column 6, lines 23-46). However, in claim 1, the purchase simulator “simulates a member’s purchase of the advertising company’s product” and the product promotion analyzer “computes ... and sends a product promotion result” based on the simulation. Therefore, Kramer also fails to disclose, either expressly or implicitly, the features quoted above.

Thus, in view of the above, it is submitted that claim 1 is patentable over Valentino and Kramer.

It is submitted that claims 7, 13, 19 and 22 emphasize similar features as claim 1. Therefore, it is submitted that claims 7, 13, 19 and 22 are patentable over Valentino and Kramer, taken alone or in combination, for reasons similar to those discussed above.

The dependent claims are also patentable over Valentino and Kramer, taken alone or in combination, for at least the same reasons as their respective base claims, from which they depend.

Accordingly, withdrawal of the rejection is respectfully requested.

### **Summary**

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. Further, all pending claims patentably distinguish over the prior art. There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If any further fees, other than and except for the issue fee, are necessary with respect to this paper, the U.S.P.T.O. is requested to obtain the same from deposit account number 19-3935.

Respectfully submitted,  
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/Mehdi D. Sheikerz/

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